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8 **UNITED STATES DISTRICT COURT**  
9 **SOUTHERN DISTRICT OF CALIFORNIA**  
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11 SEIRUS INNOVATIVE ACCESSORIES,  
12 INC., a Utah Corporation,,  
13

14 Plaintiff,  
15

16 vs.  
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21 BALBOA MANUFACTURING  
22 COMPANY, LLC., a California Limited  
23 Liability Company, and SPORTS  
ACCESSORIES AMERICA, INC., a  
Colorado Corporation,  
24

25 Defendants.  
26

CASE NO. 09-CV-2274-H-WMC

**ORDER:**

**(1) GRANTING DEFENDANTS’  
MOTION FOR SUMMARY  
JUDGMENT REGARDING  
SEIRUS’ ‘804 AND ‘690  
PATENTS;**

**(2) GRANTING DEFENDANTS’  
MOTION FOR SUMMARY  
JUDGMENT REGARDING  
TRADE DRESS;**

**(3) GRANTING DEFENDANTS’  
MOTION FOR SUMMARY  
JUDGMENT ON FALSE  
DESIGNATION OF ORIGIN,  
UNFAIR COMPETITION, AND  
UNJUST ENRICHMENT  
CAUSES OF ACTION; AND**

**(4) DENYING SEIRUS’  
MOTION FOR RELIEF  
PURSUANT TO RULE 56(d)  
AND GRANTING  
DEFENDANTS’ REQUEST FOR  
JUDICIAL NOTICE**

26 On December 30, 2011, Defendants Balboa Manufacturing Company, LLC and Sports  
27 Accessories America, Inc. (collectively “Defendants”) filed motions for summary judgment  
28 regarding Seirus Innovative Accessories, Inc.’s (“Seirus” or Plaintiff”) Patent Nos. 5,214,804

1 (“the ‘804 patent”), 6,272,690 (“the ‘690 patent”), Seirus’ trade dress claims, and requested  
2 judicial notice.<sup>1</sup> (Doc. Nos. 75 & 76.) On January 16, 2012, Seirus filed a response in  
3 opposition to Defendants’ motions for summary judgment. (Doc. Nos. 79 & 85.) On January  
4 23, 2012, Defendants filed a reply. (Doc. Nos. 92 & 93.)

5 On January 16, 2012, Seirus filed a motion for relief pursuant to Rule 56(d). (Doc. No.  
6 86.) On January 23, 2012, Defendants filed a response in opposition. (Doc. No. 94.) On  
7 January 27, 2012, Seirus filed a reply. (Doc. No. 103.)

8 The Court held a hearing on January 30, 2012. Matthew Murphey and Paul McGowan  
9 appeared for Seirus, and Steele Gillaspey appeared for Defendants. Based on the following,  
10 the Court grants Defendants’ motions for summary judgment.

### 11 **Background**

12 Seirus filed an amended complaint for patent infringement, trade dress infringement,  
13 and unfair competition on February 10, 2010 against Balboa Manufacturing Company, LLC  
14 and Sports Accessories America, Inc. (Doc. No. 9, First Amended Complaint.) Specifically,  
15 Seirus alleges infringement and inducing infringement of the ‘804 patent and the ‘690 patent  
16 by the Defendants’ accused products. (Complaint at 4-10.) The ‘804 patent was filed on  
17 January 27, 1992 and issued on June 1, 1993. The ‘804 claims are directed to an article of  
18 clothing that includes a mask portion to be worn about a user’s mouth and nose, and a scarf  
19 portion to be worn about a user’s neck. (Doc. No. 85, Ex. 3, the ‘804 patent). The ‘690 patent  
20 was filed on March 18, 1996 and issued on August 14, 2001. The ‘690 patent contains a single  
21 claim directed to a “combination of a sport goggle and an article of protective clothing.” (Doc.  
22 No. 78, Ex. 1, the ‘690 patent).

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26 <sup>1</sup>Defendants requested that the Court take judicial notice of this Court’s own files, records, and  
27 orders in the case of Seirus Innovative Accessories, Inc. v. Cabela’s Inc., No. 09-CV-102 H (WMC)  
28 (Doc. Nos. 75-2; 76-2.) On January 16, 2012, Seirus filed a response in opposition to Defendants’  
request for judicial notice. (Doc. No. 81.) On January 23, 2012, Defendants filed a reply. (Doc. Nos.  
92-3; 93-1.)

Seirus also asserts claims of trade dress infringement, false designation of origin and unfair competition under the Lanham Act, and unfair competition and unjust enrichment under California law. (Doc. No. 1, Complaint at 4-10.)

## **I. Motion for Summary Judgment**

### **Legal Standard**

Summary judgment is appropriate under Rule 56 of the Federal Rules of Civil Procedure if the moving party demonstrates the absence of a genuine issue of material fact and entitlement to judgment as a matter of law. Celotex Corp. v. Catrett, 477 U.S. 317, 322 (1986). A fact is material when, under the governing substantive law, it could affect the outcome of the case. Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 248 (1986); Freeman v. Arpaio, 125 F.3d 732, 735 (9th Cir. 1997). A dispute is genuine if a reasonable jury could return a verdict for the nonmoving party. Anderson, 477 U.S. at 248.

A party seeking summary judgment bears the initial burden of establishing the absence of a genuine issue of material fact. Celotex, 477 U.S. at 323. The moving party can satisfy this burden in two ways: (1) by presenting evidence that negates an essential element of the nonmoving party's case; or (2) by demonstrating that the nonmoving party failed to establish an essential element of the nonmoving party's case on which the nonmoving party bears the burden of proving at trial. Id. at 322-23. "Disputes over irrelevant or unnecessary facts will not preclude a grant of summary judgment." T.W. Elec. Serv., Inc. v. Pacific Elec. Contractors Ass'n, 809 F.2d 626, 630 (9th Cir. 1987). Once the moving party establishes the absence of genuine issues of material fact, the burden shifts to the nonmoving party to set forth facts showing that a genuine issue of disputed fact remains. Celotex, 477 U.S. at 322. The nonmoving party cannot oppose a properly supported summary judgment motion by "rest[ing] on mere allegations or denials of his pleadings." Anderson, 477 U.S. at 256. "The 'opponent must do more than simply show that there is some metaphysical doubt as to the material fact.'" Kennedy v. Allied Mut. Ins. Co., 952 F.2d 262, 265-66 (9th Cir. 1991) (citing Matsushita Elec. Indus. Co. v. Zenith Radio Corp., 475 U.S. 574, 586 (1986)). Furthermore, the nonmoving party generally "cannot create an issue of fact by an affidavit contradicting his prior deposition

1 testimony.” Kennedy, 952 F.2d at 266; see Foster v. Arcata Assocs., 772 F.2d 1453, 1462 (9th  
 2 Cir. 1985), cert. denied, 475 U.S. 1048 (1986); Radobenko v. Automated Equip. Corp., 520  
 3 F.2d 540, 543-44 (9th Cir. 1975).

4 When ruling on a summary judgment motion, the court must view all inferences drawn  
 5 from the underlying facts in the light most favorable to the nonmoving party. Matsushita Elec.  
 6 Indus. Co., 475 U.S. at 587. The Court does not make credibility determinations with respect  
 7 to evidence offered. See T.W. Elec., 809 F.2d at 630-31 (citing Matsushita, 475 U.S. at 587).  
 8 Summary judgment is therefore not appropriate “where contradictory inferences may  
 9 reasonably be drawn from undisputed evidentiary facts.” Hollingsworth Solderless Terminal  
 10 Co. v. Turley, 622 F.2d 1324, 1335 (9th Cir. 1980).<sup>2</sup>

#### 11 **A. Seirus’ Claims for Patent Infringement**

12 Seirus claims (i) patent infringement and (ii) inducing patent infringement of U.S.  
 13 Patent Nos. 5,214,804 (“the ‘804 patent”) and 6,272,690 (“the ‘690 patent”) against  
 14 Defendants. Defendants move for summary judgment regarding these claims asserting that the  
 15 claims of the ‘804 patent are invalid and that Defendants’ products do not infringe the ‘690  
 16 patent.

#### 17 **1. The ‘804 Patent**

18 The ‘804 patent describes an article of clothing that combines a mask portion to be worn  
 19 about a user’s mouth and nose with a scarf portion to be worn about a user’s neck. Defendants  
 20 argue that the claims of the ‘804 patent are invalid as obvious over the prior art and, therefore,  
 21 cannot be infringed either directly or by inducement.

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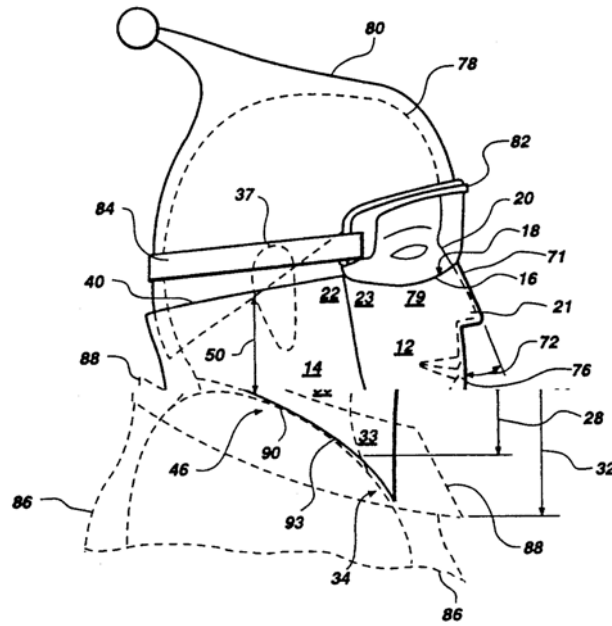
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 27 <sup>2</sup>The Court denies Seirus’ motion under Rule 56(d). Given that Seirus filed this action in 2009,  
 28 the Court concludes that the parties have had adequate time to litigate this matter. Accordingly, the  
 Court denies Seirus’ motion for relief pursuant to Rule 56(d).



#### a. Legal Standard for Obviousness

A patent issued by the United States Patent and Trademark Office (“USPTO”) is presumed to be valid. Microsoft Corp. v. i4i Ltd. P’ship, 131 S.Ct. 2238, 2242 (2011). In order to overcome the presumption of validity, a party must prove invalidity by clear and convincing evidence. Id.

A claimed invention is obvious if “the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art.” 35 U.S.C. § 103(a). Obviousness is a legal question based on underlying factual determinations. Eisai Co. Ltd. v. Dr. Reddy’s Lab., Ltd., 533 F.3d 1353, 1356 (Fed. Cir. 2008). “The factual determinations underpinning the legal conclusion of obviousness include 1) the scope and content of the prior art, 2) the level of ordinary skill in the art, 3) the differences between the claimed invention and the prior art, and 4) evidence of secondary factors.” Id. (citing Graham v. John Deere Co., 383 U.S. 1, 17-18 (1966)). Secondary factors include “commercial success, long felt but unsolved needs, failure of others, etc.” KSR Int’l Co. v. Teleflex Inc., 550 U.S. 398, 406 (2007) (quoting Graham, 383 U.S. at 17-18.) Summary judgment may be appropriate if “the content of the prior art, the scope of the patent claim, and

1 the level of ordinary skill in the art are not in material dispute, and the obviousness of the claim  
2 is apparent.” KSR Int’l Co. at 427.

3 A patent is likely to be obvious if it merely yields predictable results by combining  
4 familiar elements according to known methods. Id. at 416. “[A] patent composed of several  
5 elements is not proved obvious merely by demonstrating that each of its elements was,  
6 independently, known in the prior art.” Id. at 418. “If a person of ordinary skill in the art can  
7 implement a predictable variation, and would see the benefit of doing so, § 103 likely bars its  
8 patentability.” Id. at 417. In determining obviousness, courts do not need to find “precise  
9 teachings directed to the specific subject matter of the challenged claim, for a court can take  
10 account of the inferences and creative steps that a person of ordinary skill in the art would  
11 employ.” Id. at 418. A person of ordinary skill interprets the prior art “using common sense  
12 and appropriate perspective.” Unigene Labs., Inc. v. Apotex, Inc., 655 F.3d 1352, 1361 (Fed.  
13 Cir. 2011) (citing KSR Int’l Co., 550 U.S. at 421). As the Supreme Court observed:

14 When there is a design need or market pressure to solve a problem and there  
15 are a finite number of identified, predictable solutions, a person of ordinary  
16 skill has good reason to pursue the known options within his or her technical  
grasp. If this leads to the anticipated success, it is likely the product not of  
innovation but of ordinary skill and common sense.

17 KSR Int’l Co., 550 U.S. at 421. The results of ordinary innovation are not patentable. Id. at  
18 427.

#### 19 **b. Claims 1-4 and 8-15: Obviousness Analysis**

20 Claim 1 is directed to an article of clothing comprising three elements: i) a mask  
21 member with an upper edge and a lower edge; ii) a scarf member secured to the mask member;  
22 and iii) a securing means associated with the scarf member. ‘804 patent col.6 ll.45-66. The  
23 upper edge of the mask member extends along the lower part of the user’s eye socket areas  
24 contouredly over the nose. Id. The lower edge extends under the user’s chin and upwardly  
25 toward the upper edge on both sides of the face rearward of the eye socket areas. Id. The  
26 upper edge extends rearwardly to the area of the temples, and the lower edge is arcuate and  
27 intersects the upper edge in the area of the temples. Id. The scarf member is secured to said  
28 mask member along the lower edge and is sized to extend from the lower edge substantially

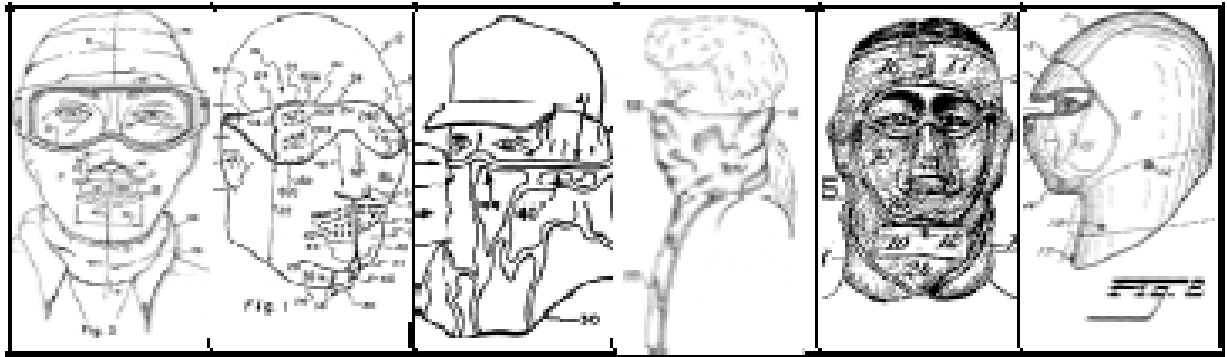
1 the height of the neck of the user and in width rearwardly about the neck on both sides of the  
2 user's head. Id. The securing means is used to secure the article of clothing about the head  
3 of the wearer. Id.

4 Claim 2 depends from claim 1, and further requires that the scarf member to have "a left  
5 side and a right side which extend rearwardly and are sized to surround the neck of the user."  
6 Id. at col.6 l.67 - col.7 l.2. Claim 3 depends from claim 2, and additionally requires that the  
7 area under the chin of the scarf member extend in height "from the lower edge of the mask  
8 member to the chest area of the user." Id. at col.7 ll.3-6.

9 Claim 4 includes all the limitations of claim 1, and further includes limitations relating  
10 to the scarf member. Specifically, claim 4 further limits the scarf member to include a left side  
11 and a right side that are sized to surround the neck of the user, and to require the area of the  
12 scarf member under the chin of the user to extend in height from the lower edge of the mask  
13 member to the chest area of the user. Id. at col.7 ll.7-35.

14 Claim 5 depends from claim 4, and additionally requires that the scarf member "extends  
15 from the lower edge at the temple area rearwardly about the head of the user." Id. at col.7  
16 ll.36-38. Claims 8-15 ultimately depend from claims 1 or 4, and recite various limitations  
17 directed to the materials of the mask and scarf members. Id. at col.8 ll. 6-30.

18 Defendants cite a number of prior art references to demonstrate the scope and content  
19 of the prior art. Defendants assert that various combinations of these references render the  
20 '804 patent invalid for obviousness. (Doc. No. 76-1 at 7-10.) Six of the references cited by  
21 Defendants were not before the USPTO when the '804 patent application was examined,  
22 including U.S. Patent Nos. 5,025,507 ("the '507 patent"), 4,718,123 ("the '123 patent"),  
23 2,686,317 ("the '317 patent"), 5,109,548 ("the '548 patent"), 202,262 ("the '262 patent"), and  
24 4,768,235 ("the '235 patent"). The cited references that were before the USPTO were  
25 analyzed under pre-KSR obviousness standards, and include U.S. Patent Nos. 4,300,240 ("the  
26 '240 patent"), 4,825,474 ("the '474 patent"), 772,148 ("the '148 patent"), 4,941,211 ("the '211  
27 patent"), and 766,963 ("the '963 patent"). Representative figures of the prior art references  
28 are pictured below:



'240

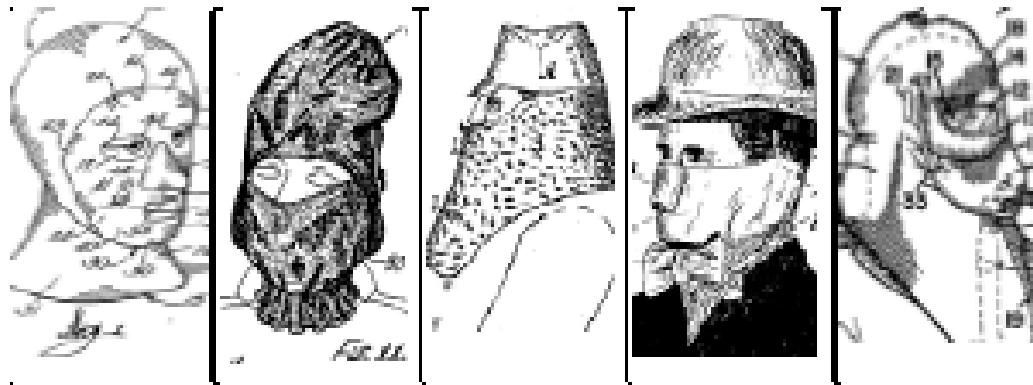
'474

'507

'123

'148

'317



'211

'548

'262

'963

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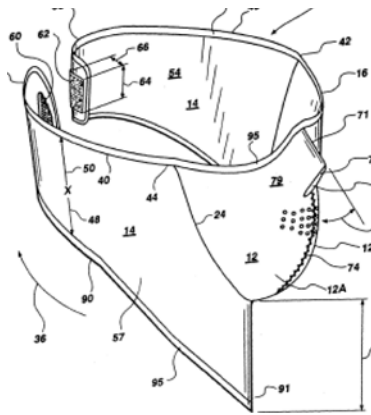
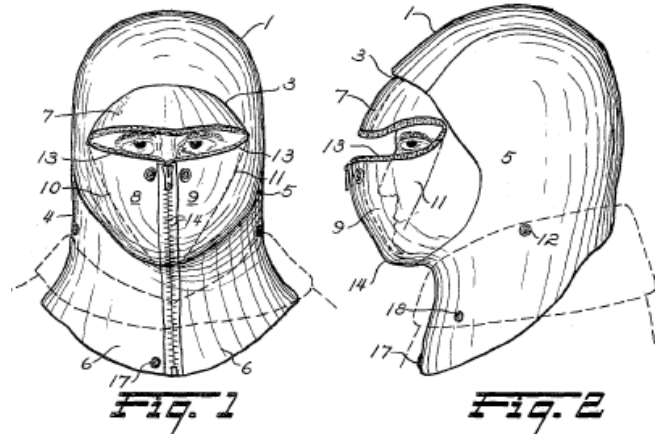
A patent is likely to be obvious if it merely yields predictable results by combining familiar elements according to known methods. KSR Int'l Co., 550 U.S. at 418. The claimed elements of the '804 patent are familiar elements as shown by the many prior art patents cited by Defendants. The record shows that combining the various elements using known methods, as shown in the prior art, would yield predictable results for cold weather head gear. For example, the '317 patent, which was not before the USPTO, discloses head wearing apparel for protecting a wearer against severe weather conditions. '317 patent col.1 ll.1-4. The '317 patent discloses all elements of claims 1-5 of the '804 patent except the "securing means" of claims 1 and 4. Representative figures of the '804 and '317 patents are pictured below for reference:

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**'804 Patent****'317 Patent**

The '317 patent teaches a mask member as claimed in claims 1 and 4. Specifically, flaps 8 and 9 make up the mask portion and extend from the opposite sides 4 and 5 of the hood. '317 patent col.2 ll.52-55. The flaps are described as "namely face covering portions of cupped formation and generally triangular in shape." *Id.* The prior art patent further describes an upper edge 13 of the mask portion that has a relatively horizontal position in front of the face slightly below the eyes, and a lower edge of the mask portion that is positioned under the chin that extends toward the horizontal edge. *Id.* at fig. 2, item 13, col.2 ll.21-31, and col.3 ll.33-40. The upper edge 13 extends along the lower part of the eye socket areas and over the nose. The upper edge 13 also extends rearwardly to the area of the temples. Figure 2 shows that the upper edge 13 intersects the lower edge of the mask portion in the area of the temples. *Id.* at fig. 2, item 13.

The '317 patent teaches a scarf member as claimed in claims 1 and 4. For example Figure 1 of the '317 contains a scarf portion 6 that extends from the lower edge of the mask member rearwardly to surround the neck of the wearer on both sides of the head. *Id.* at fig. 1, item 6, and col.2 ll.31-40. The scarf member 6 has left and right sides that extend to surround the user's neck, as claimed by the '804 patent in claims 2 and 4. *Id.* at fig. 1, item 6. The scarf portion 6 covers the chest of the wearer and has two sides that come together to surround the neck of the wearer, as required by claims 3 and 4 of the '804 patent. *Id.* at fig. 1, item 6, and

1 col.2 ll.35-37. The scarf portion 6 extends from the mask portion at the wearer's temples to  
2 surround the wearer's head, as claimed by the '804 patent in claim 5. Id.

3 The '317 patent describes a fastening device that operates to open or close the entire  
4 mask and scarf portions in the front portion of the garment. '317 patent figs. 1 and 3, item 15.  
5 Other prior art references disclose the claimed securing means of claims 1 and 4 of the '804  
6 patent. For example, U.S. Patent No. 4,718,123 ("the '123 patent") teaches a garment for  
7 covering the neck of a wearer that has appendages that wrap around the neck and fasten to one  
8 another at the ends using a releasable fastener, such as Velcro, buttons, zippers, or snaps. '123  
9 patent fig. 1, items 2-3, fig. 2, item 10, and col.1 ll.52-57. Further, U.S. Patent No. 4,300,240  
10 ("the '240 patent") discloses a mask with securing means, such as adjustable velcro strips, for  
11 securing the mask around the wearer's head. '240 patent fig. 1, items 88 and 90, and col.4  
12 ll.52-57.

13 A patent that is merely a combination of familiar elements combined using known  
14 methods that produces predictable results is likely obvious. KSR Int'l Co., 550 U.S. at 418.  
15 Here, modifying the scarf portion of the '317 patent to include the fasteners of the '123 patent  
16 would yield predictable results. The Supreme Court noted in KSR that, when determining  
17 obviousness, "neither the particular motivation nor the avowed purpose of the patentee  
18 controls." Id. at 419.

19 Moreover, during prosecution of the '804 patent application, the patent examiner noted  
20 in the Notice of Allowance that, "[n]one of the cited references alone or in combination  
21 disclose an article of clothing comprising a mask and an attached scarf member where the  
22 mask has an upper edge and a lower edge and where the upper edge extends rearwardly to the  
23 area of the wearers [sic] temples and where the lower edge is arcuate and intersects the upper  
24 edge in the area of the temples." '804 patent, Notice of Allowance of Feb. 19, 1993, at 2. The  
25 undisclosed '317 patent describes a lower edge and a horizontal upper edge 13 of a mask  
26 portion that intersect approximately at the wearer's temples. '317 patent fig. 2, item 13.  
27 Significantly, the '317 patent was not before the examiner. Therefore, the examiner's reasons  
28 for allowing the '804 patent are undercut by the existence of the '317 patent.

1 The ultimate judgment of obviousness is a question of law for the Court. KSR Int'l Co.,  
 2 550 U.S. at 427. Considering the prior art, the scope of the patent claims, and the level of skill  
 3 in the art,<sup>3</sup> the Court concludes that the record demonstrates no triable issue of material fact  
 4 on obviousness for claims 1-5 of the '804 patent. See, e.g., Media Tech. Licensing, LLC v.  
 5 Upper Deck Co., 596 F.3d 1334, 1339 (Fed. Cir. 2010) (affirming a district court's summary  
 6 judgment of obviousness for claims directed to a piece of memorabilia attached to a trading  
 7 card); Rothman v. Target Corp., 556 F.3d 1310, 1322 (Fed. Cir. 2009) (affirming a jury verdict  
 8 of obviousness for claims directed to a nursing garment containing an invisible breast support).

9 Dependent claims 8-12 recite various limitations directed to the materials of the mask  
 10 and scarf members. '804 patent col.8 ll.6-18. The '804 patent indicates that materials within  
 11 the scope of claims 8-12 were known in the art. For example, POLAR TEC™ is a flexible,  
 12 stretchable, fleece-like material that was previously known in the art that falls within the  
 13 material of claims 8-12. Id. at col.4 ll.42-55. Additionally, stretchable mask material of claim  
 14 8, such as nylon covered close sponge neoprene is disclosed by the '240 patent. '240 patent  
 15 col.5 ll.45-50. A mask made of the fleece layer and water resistant layer of claims 9-10, such  
 16 as a mask made of nylon covered close cell sponge neoprene, is disclosed by the '240 patent.  
 17 Id. at col.5 ll.45-67. A scarf made of the soft stretchable fleece-like material of claims 11-12,  
 18 such as a laminated fabric made of spandex and polyurethane laminate bound to an insulating  
 19 fleece-knit polyester fabric, is disclosed by the '548 patent. '548 patent col.1 ll.64-68, and

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21  
 22 <sup>3</sup>A specific finding on the level of skill in the art is not required "where the prior art itself  
 23 reflects an appropriate level and a need for testimony is not shown." Litton Indus. Prods., Inc. v. Solid  
 24 State Sys. Corp., 755 F.2d 158, 163-64 (Fed. Cir. 1985). Nevertheless, it is preferable for the court  
 to specify the level of skill it applies to the invention at issue. Okajima v. Bourdeau, 261 F.3d 1350,  
 1355 (Fed. Cir. 2001). "[E]xpert testimony is not required when the references and the invention are  
 easily understandable." Wyers v. Master Lock Co., 616 F.3d 1231, 1242 (Fed. Cir. 2010).

25 Defendants argue that the prior art reflects the level of skill in the art as that of an ordinary  
 26 layman because the technology associated with cold weather head gear is simple and easily  
 27 understood. (Doc. No. 109 at 2-3.) For example, the inventor of similar cold weather head gear was  
 28 an opera singer who had lived in very cold climates. '123 patent col.1 ll.5-6. Nevertheless, the Court  
 has carefully considered the technology at issue and concludes that a person of ordinary skill in the  
 art possess a undergraduate degree in textile, mechanical, or materials engineering for the purpose of  
 evaluating the '804 patent for obviousness. (See, e.g., Cabela's, No. 09-CV-102-H (WMC), Doc. No.  
 267-4 at 4.)

1 col.4 ll.1-18, 53-58. Thus, the materials of claims 8-12 were available at the time the ‘804  
2 patent was filed. Accordingly, the Court concludes that there is no triable issue as to whether  
3 the types of materials recited in the claims were well known in cold weather apparel design.  
4 As a result, the Court determines that it would have been obvious to use these materials to  
5 produce the article of clothing of claims 8-12.

6 Dependent claims 13-15 recite limitations directed to a “middle edge” of the mask  
7 member “for positioning under the user’s nose and sized to extend substantially the width of  
8 the user’s nose.” ‘804 patent col.8 ll.19-30. The ‘240 patent discloses all of the features of the  
9 middle edge recited in claims 13-15. ‘240 patent fig. 3, item 32 and col. 3 ll.27-67. For  
10 example, the ‘240 patent discloses, “a middle edge 32 in the area above the upper lip. The  
11 middle edge 32 extends essentially the width 33 of the nose piece 26, as best seen in fig. 3.  
12 The nose piece 26, together with the middle edge 32, form a breathing aperture 34 for the  
13 nostrils.” *Id.* Therefore, the Court concludes that the record shows that it would have been  
14 obvious to add a middle edge to a mask member. Accordingly, the Court grants Defendants’  
15 summary judgment motion with respect to the invalidity of claims 1-4 and 8-15 from the ‘804  
16 patent for obviousness.

### 17 **c. Claims 1-4 and 8-15: Collateral Estoppel**

18 When a court has decided an issue of fact or law necessary to its judgment, collateral  
19 estoppel may preclude relitigation of the issue. Hydranautics v. FilmTec Corp., 204 F.3d 880,  
20 885 (9th Cir. 2000). The use of collateral estoppel is permitted to prevent relitigating the  
21 validity of a patent after a court has already declared the patent to be invalid. Blonder-Tongue  
22 Lab., Inc., v. Univ. of Ill. Foundation, 402 U.S. 313, 350 (1971). Collateral estoppel applies  
23 only where it is established that:

- 24 (1) the issue necessarily decided at the previous proceeding is identical to the
- 25 one which is sought to be relitigated;
- 26 (2) the first proceeding ended with a final judgment on the merits; and
- 27 (3) the party against whom collateral estoppel is asserted was a party or in
- 28 privity with a party at the first proceeding.

Hydranautics, 204 F.3d at 885 (citations omitted).

This Court issued a final judgment on December 12, 2011 concluding that claims 1-4 and 8-15 of the '804 patent are invalid as obvious under 35 U.S.C. § 103(a). (Cabela's, No. 09-CV-102-H (WMC), Doc. No. 493.) Seirus, the plaintiff in Cabela's, is asserting the identical claims against Defendants in this case. Therefore, the Court alternatively applies the doctrine of collateral estoppel and precludes Seirus from relitigating the validity of claims 1-5 and 8-15 in this case. Accordingly, the Court grants Defendants' summary judgment motion with respect to the invalidity of claims 1-4 and 8-15 from the '804 patent.

#### d. Claims 6 and 7

Claim 6 of the '804 patent requires the claimed scarf member to have "an upper edge which is in alignment with the said upper edge of said mask member." '804 patent col.7 ll.39-41. Claim 7 of the '804 patent depends from claim 6 and requires that the "left side and said right side of said scarf member extend in height from their upper edge downwardly substantially to the shoulders of the user rearwardly of the temple area." '804 patent col.8 ll.1-5. Defendants seek summary judgment as to the obviousness of claims 6 and 7 in light of the '123, '507, '548, '262, and '317 patents.

With respect to claim 6, Defendants allege that aligning a scarf member with a mask member is a familiar element known in the prior art as demonstrated by the following figures that were not before the patent examiner during the prosecution of the '804 patent.

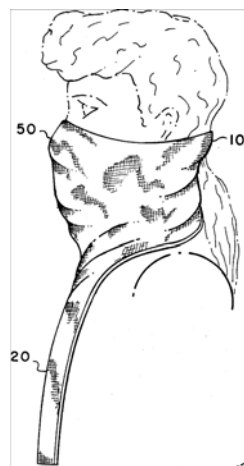


Fig. 2 of the '123 patent

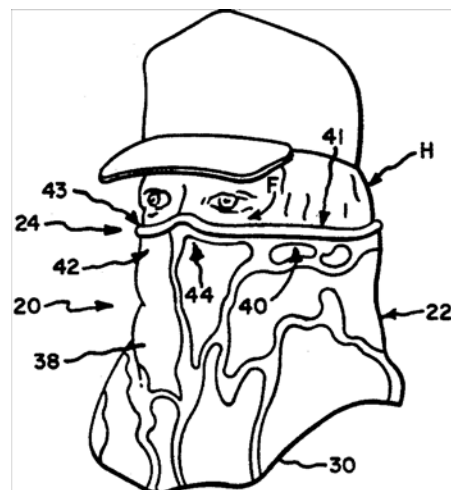


Fig. 1 of the '507 patent



Fig. 11 of the '548 patent

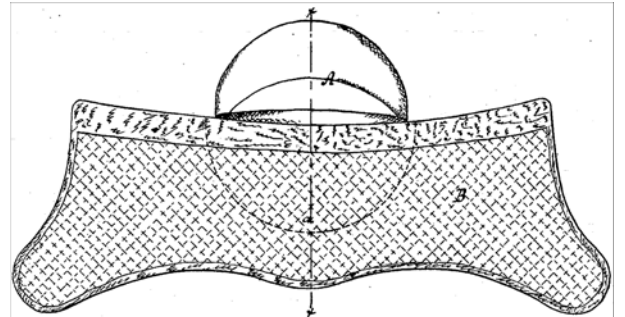


Fig. 1 of the '262 patent

Defendants further argue that the addition of a scarf member in alignment with a mask member would yield predictable results for cold weather head gear and produces an obvious combination under KSR.

With respect to claim 7, Defendants allege that the '548, '123, '262, and '507 patents disclose a scarf member with right and left sides that extend from the temple area to the shoulders. Defendants further contend that extending the scarf member from the temple area to the shoulders yields predictable results and produces an obvious combination.

The Court agrees that claims 6 and 7 are obvious in light of the prior art. See KSR Int'l Co., 550 U.S. at 427. For example, the '317 patent teaches all elements of claim 6, excepting the securing means and the alignment of the upper edge of the scarf and mask members. The '123 patent teaches the claimed securing means and a scarf member with an upper edge. '123 patent fig. 2, col.1 ll.50-57. The '123, '507, and '548 patents show scarf members with right and left sides that extend from the temple area to the shoulders. See '123 patent fig. 2; '507 patent fig. 1; '548 patent fig. 11. In KSR, the Supreme Court held that "the results of ordinary innovation are not the subject of exclusive rights under the patent laws." KSR Int'l Co., 550 U.S. at 427. As a result, these claims fail to meet the requirement of 35 U.S.C. § 103(a). Seirus has not shown any secondary factors to dislodge the determination that claims 6 and 7 are obvious. Therefore, the Court concludes that the record shows that it would have been obvious to align the upper edge of the scarf and mask members. The Court concludes that the



record shows that it would have been obvious to have a scarf member with right and left sides that extend from the temple areas to the shoulders. Accordingly, the Court grants Defendants' summary judgment motion with respect to the invalidity of claims 6 and 7 from the '804 patent for obviousness.

### e. Claim 16

Claim 16 of the '804 patent depends from claim 6 and requires that the "upper edge of said mask member and said scarf member have piping affixed thereto and there along." '804 patent col.8 ll.31-33. Defendants seek summary judgment as to the obviousness of claim 16 in light of Figures 1 and 2 of the '507 patent and Figure 12 of the '548 patent. Specifically, Defendants allege that the figures from these patents show a piping on the upper edge of cold weather headgear.

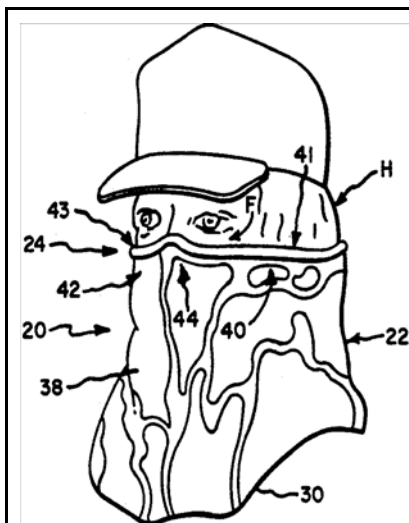


Fig. 1 of the '507 patent

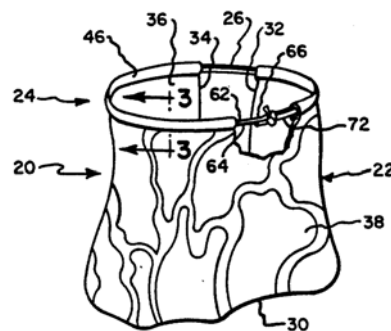


Fig. 2 of the '507 patent



Fig. 12 of the '548 patent

Defendants further contend that affixing piping to the upper edges of mask and scarf members would yield predictable results for cold weather head gear and produces an obvious combination.

The Court concludes that it would have been obvious for a person skilled in the art at the time the '804 patent was filed to arrive at the piping of claim 16. The Court has construed the term "piping affixed thereto and there along" to mean that "piping is affixed to and extends

1 along the upper edge of the mask member and scarf member.” (Doc. No. 44 (citing Cabela’s,  
2 No. 09-CV-102-H (WMC), Doc. No. 139 at 10).) The “strip” disclosed in the ‘507 patent is  
3 a relatively soft material that is folded over upon itself so that the strip edges engage on  
4 another and define a sleeve. ‘507 patent col.4 ll.6-19. A layperson designing cold weather  
5 head gear would have been able to substitute the “strip” of the ‘507 patent with the “piping”  
6 of the ‘804 patent to arrive at the article of clothing of claim 16. See, e.g., KSR Int’l Co., 550  
7 U.S. at 418 (explaining the court “need not seek out precise teachings directed to the  
8 challenged claim’s specific subject matter, for a court can consider the inferences and creative  
9 steps a person of ordinary skill in the art would employ”). Therefore, the Court grants  
10 Defendants’ summary judgment motion with respect to the invalidity of claim 16 of the ‘804  
11 patent for obviousness.

12 **f. Claims 17 and 18**

13 Claim 17 of the ‘804 patent refers to “co-acting fasteners secured to said left side and  
14 said right side of said scarf member.” ‘804 patent col.8 ll.34-36. Claim 18 depends from claim  
15 17 and further requires that the co-acting fasteners are “pile and hook fasteners.” Id. at col.8  
16 ll.37-38. Defendants seek summary judgment as to the obviousness of claims 17 and 18 in light  
17 of the ‘123, ‘240, and ‘474 patents. Specifically, Defendants allege that the figures from these  
18 patents show co-acting Velcro® pile and hook fasteners that are secured to the left and right  
19 side of the scarf member.

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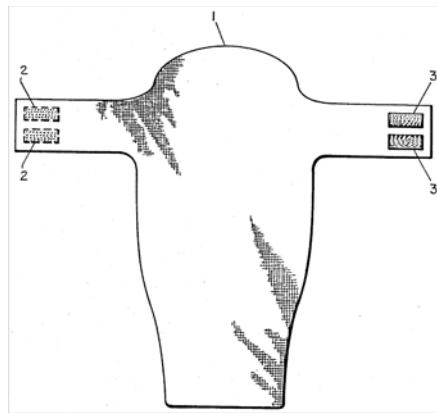


Fig. 1 of the '123 patent

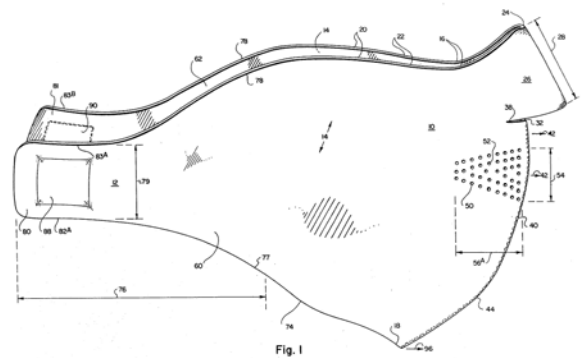


Fig. 1 of the '240 patent

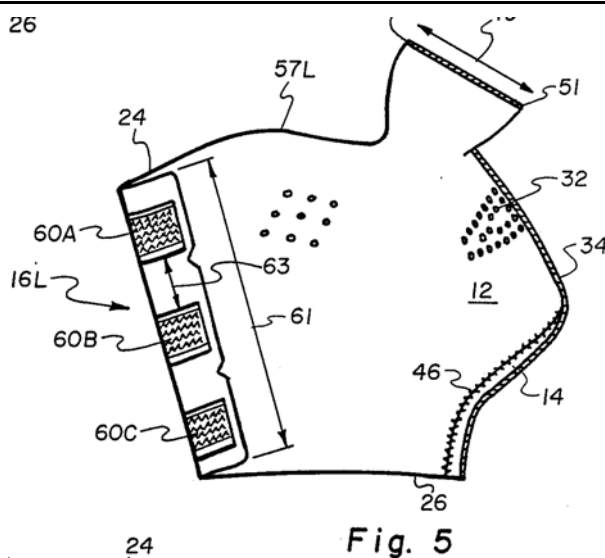


Fig. 5 of the '474 patent

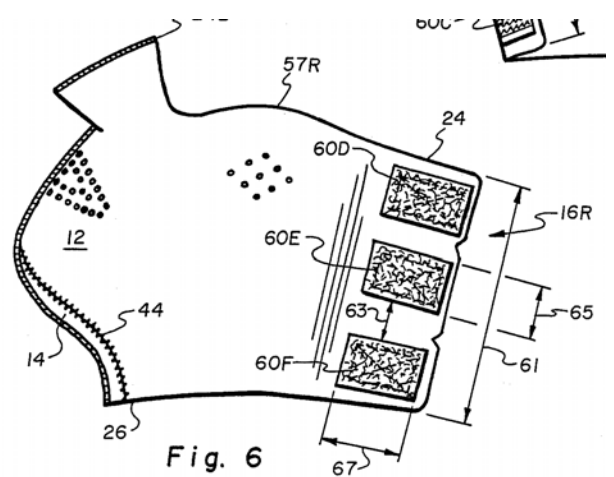


Fig. 6 of the '474 patent

Defendants further argue that the addition of co-acting fasteners, such as Velcro® pile and hook fasteners, yields predictable results for cold weather head gear and produces an obvious combination.

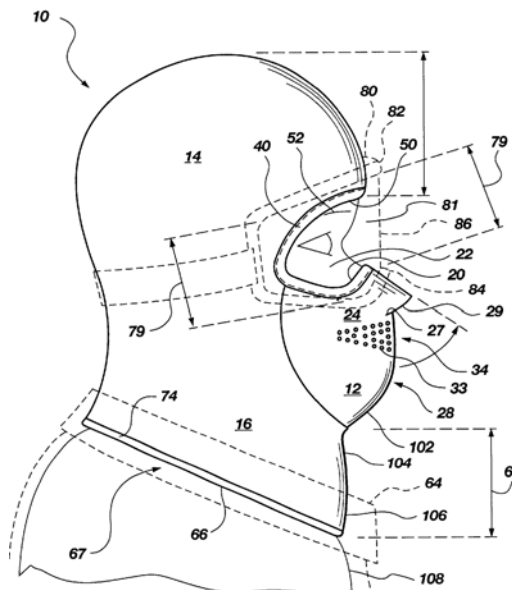
Seirus does not dispute that the cited patents show Velcro® pile and hook fasteners. Instead, Seirus argues that Defendants' analysis is insufficient because it merely attempts to establish that the elements of claim 17 and 18 were independently known in the prior art.

The Court concludes that summary judgment as to the invalidity of dependent claims 17 and 18 is appropriate. The '123 and '240 patents disclose the type of co-acting fasteners

recited in claims 17 and 18 of the '804 patent. In particular, Figure 1 of the '123 patent and Figure 1 of the '240 patent disclose Velcro® pile and hook fasteners that are secured to the sides of a scarf. Combining the additional element of co-acting fasteners with the other obvious elements of claims 1 and 2 would yield predictable results for cold weather head gear. KSR Int'l Co., 550 U.S. at 416 ("A patent is likely to be obvious if it merely yields predictable results by combining familiar elements according to known methods."). Therefore, the Court concludes that the record demonstrates no triable issue of material fact on the obviousness of claims 17 and 18 of the '804 patent. The Court grants Defendants' summary judgment motion of invalidity.

## 2. The '690 Patent

The '690 patent contains a single claim directed to a "combination of a sport goggle and an article of protective clothing." Id. at col.6 ll.20-55. The article of clothing includes a mask member for placement about a user's mouth and nose, a head member connected to the mask member for placement about a user's head, and a scarf portion for placement about the user's neck. Id.



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**a. Legal Standard for Infringement and Inducing Infringement**

Literal infringement of a claim of a utility patent is established when it is determined that “every limitation in the claim is literally met by the accused device.” Kahn v. General Motors Corp., 135 F.3d 1472, 1476 (Fed. Cir. 1998). “In determining whether there has been infringement, a two step analysis is required. First, the claims must be correctly construed to determine the scope of the claims. Second, the claims must be compared to the accused device.” Id.

An accused device “that does not literally infringe upon the express terms of a patent claim may nonetheless be found to infringe if there is ‘equivalence’ between the elements of the accused product or process and the claimed elements of the patented invention.” Warner-Jenkinson Co. v. Hilton Davis Chem. Co., 520 U.S. 17, 21 (1997). However, “the use of the doctrine of equivalents to establish infringement is limited by the doctrine of prosecution history estoppel.” Voda v. Cordis Corp., 536 F.3d 1311, 1324-25 (Fed. Cir. 2008) (citing Warner-Jenkinson, 520 U.S. at 30). Prosecution history estoppel operates by “barring an equivalents argument for subject matter relinquished when a patent claim is narrowed during prosecution.” Voda, 536 F.3d at 1324-25.

A patentee may prevail on a claim of infringement by inducement where it shows direct infringement and that the alleged infringer knowingly induced infringement and specifically intended to encourage another’s infringement. Broadcom Corp. v. Qualcomm, Inc., 543 F.3d 683, 697 (Fed. Cir. 2008). In other words, an accused infringer must be shown to have intended to cause the acts of direct infringement and at least should have known that its conduct would cause such direct infringement. Id. at 698.

In a motion for summary judgment of non-infringement, “[t]he movant bears the burden of demonstrating absence of all genuine issues of material fact, the district court must view the evidence in a light most favorable to the nonmovant and draw all reasonable inferences in its favor, and must resolve all doubt over factual issues in favor of the party opposing summary judgment.” SRI Int’l. v. Matsushita Elec. Corp. of Am., 775 F.2d 1107, 1116 (Fed. Cir. 1985).

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**b. Sports Goggles Provided in Combination with Clothing**

Claim 1 of the '690 patent is directed to the "combination of a sport goggle and an article of protective clothing." '690 patent col.6 ll.20-55. Seirus and Defendants agreed to adopt the Court's claim constructions from Cabela's. (Doc. No. 71.) In Cabela's, this Court required that the claimed sports goggles "must be provided in combination with an article of clothing." (Cabela's, No. 09-CV-102-H (WMC), Doc. No. 139 at 12.)

Jennifer Struebing, a managing member of Balboa, provided a sworn affidavit that Balboa has never packaged or sold a balaclava in combination with sports goggles. (Doc. No. 76-3.) Based on Ms. Struebing's statement, Defendants contend that the accused products do not meet the limitation requiring that sports goggles must be provided in combination with an article of clothing. Therefore, Defendants argue that they cannot be liable for literal infringement of the '690 claim because its products do not met every limitation of the claim.

Seirus attempts to rely on websites to show that Defendants permit customers to purchase balaclavas and goggles together. (Doc. No. 79.) In Cabela's, this Court previously rejected Seirus' argument that the purchase of goggles and an article of clothing at the same time constitutes a combination within claim 1 of the '690 patent. (Cabela's, No. 09-CV-102-H (WMC), Doc. No. 440 at 11.) None of the exhibits produced by Seirus show Defendants selling goggles in combination with balaclavas. Instead, the exhibits merely demonstrate that Defendants sell goggles, balaclavas, and other products. There is no showing in the exhibits or otherwise that Defendants sell goggles in combination with an article of clothing. Therefore, the Court concludes that Defendants do not meet the combination limitation of claim 1. Accordingly, there is no triable issue of material fact regarding literal or inducing infringement and the Court grants Defendants' motion for summary judgment of noninfringement of the '690 patent.

**B. Trade Dress**

Seirus claims trade dress rights in its products and packaging. Neither Seirus' alleged trade dress in its products nor Seirus' alleged trade dress in its packaging are registered with the United States Patent and Trademark Office.

In order to prevail on a claim for infringement of an unregistered trade dress, the plaintiff bears the burden to prove each of the following elements: (1) the trade dress is nonfunctional; (2) the plaintiff owns a protectable trade dress in a clearly articulated design or combination of elements that is either inherently distinctive or has acquired distinctiveness through secondary meaning; and (3) the accused mark or trade dress creates a likelihood of confusion as to source, or as to sponsorship, affiliation or connection. 15 U.S.C. § 1125(a)(3); Art Attacks Ink, LLC v. MGA Entm't Inc., 581 F.3d 1138, 1145 (9th Cir. 2009). Accordingly, in order for Seirus to succeed on its trade dress claims, Seirus must first establish that it has protectable trade dress rights in its products and packaging.

### **1. Seirus' Alleged Trade Dress in its Products**

Seirus initially identified the following trade dress: headwear including an angled beak in combination with (1) logo placed proximate the cheek; (2) opening below the nose/above the mouth; (3) holes proximate the user's mouth in a diamond pattern; (4) articulated chin; or (5) equilateral curvature underlying the eyes, that when presented, the combination resembles the contours and angles of the human face. (Doc. No. 75-3 at 4.) This alleged trade dress is identical to the one Seirus alleged in Cabela's. (No. 09-CV-102-H (WMC), Doc. No. 229, Murray Decl. ¶ 2, Ex. A at 4.)

Following Defendants' motion for summary judgment, Seirus tried to supplement its alleged trade dress. (Doc. No. 79 at 4.) Defendants assert that Seirus is bound by its previous trade dress identification. (Doc. No. 92 at 6-7.) The Court would expect a party suing for trade dress infringement to identify its trade dress in response to interrogatories. Nevertheless, the Court addresses the inadequacy of Seirus' newly alleged trade dress.

Seirus' updated product trade dress includes: (1) an angled beak; (2) a triangular opening below the nose and above the mouth; (3) a diamond shaped set of holes in the mouth area; (4) a curved chin area; (5) an equilateral concave curved opening from the top of the nose to underneath the eyes; and (6) logo placed proximate the cheek bone. (Doc. No. 79 at 4.) Seirus also contends that its trade dress includes the color black. (Id.)

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**a. Nonfunctional**

Trade dress protection extends only to product features that are not functional. Disc Golf Ass'n v. Champion Disc, Inc., 158 F.3d 1002, 1006 (9th Cir. 1998). Trade dress is functional “if it is essential to the use or purpose of the article or if it affects the cost or quality of the article.” TrafFix Devices, Inc. v. Mktg. Displays, Inc., 532 U.S. 23, 33 (2001). “In determining functionality, a product’s trade dress must be analyzed as a whole.” First Brands Corp. v. Fred Meyer, Inc., 809 F.2d 1378, 1381 (9th Cir. 1987); see also Stormy Clime Ltd. v. ProGroup, Inc., 809 F.2d 971, 974 (2d Cir. 1985) (holding that unique arrangements of purely functional features constitute a functional design and are not entitled to trade dress protection). Functional features of a product are features which constitute the actual benefit that the consumer wants to purchase, as distinguished from an assurance that a particular entity made, sponsored, or endorsed a product. Rachel v. Banana Republic, Inc., 831 F.2d 1503, 1506 (9th Cir. 1987). “The fact that individual elements of the trade dress may be functional does not necessarily mean that the trade dress as a whole is functional; rather, ‘functional elements that are separately unprotectable can be protected together as part of a trade dress.’” Clicks Billiards, Inc. v. Sixshooters Inc., 251 F.3d 1252, 1259 (9th Cir. 2001) (quoting Le Sportsac, Inc. v. K Mart Corp., 754 F.2d 71, 76 (2d Cir. 1985)).

The Ninth Circuit weighs four factors in determining whether a product feature is functional: (1) whether the design yields a utilitarian advantage; (2) whether alternative designs are available; (3) whether advertising touts the utilitarian advantages of the design; and (4) whether the particular design results from a comparatively simple or inexpensive method of manufacture. Disc Golf, 158 F.3d at 1006. No one factor is dispositive; all should be weighed collectively. Int’l Jensen, Inc. v. Metrosound U.S.A., Inc., 4 F.3d 819, 823 (9th Cir. 1993).

The plaintiff bears the burden of proving non-functionality – the accused need not prove that the trade dress at issue is functional. Rachel, 831 F.2d at 1506. When a plaintiff fails to produce evidence such that a reasonable trier of fact could find the design nonfunctional, “the district court must enter summary judgment in favor of the defendant.” Cont’l Lab. Prods., Inc.

1 v. Medax Int'l, Inc., 114 F. Supp. 2d 992, 1014-15 (S.D. Cal. 2000) (citing Disc Golf, 158 F.3d  
2 at 1009-10).

3 The Court concludes that Seirus' alleged product trade dress is functional. Seirus'  
4 design features do not distinguish the look of the products, but rather permit the user to breathe  
5 and see while wearing the product. Trade dress is functional "if it is essential to the use or  
6 purpose of the article or if it affects the cost or quality of the article." TrafFix, 532 U.S. at 33.  
7 Seirus' angled beak that covers the nose, the diamond shaped hole that allows users to breathe  
8 through their mouth, and the opening allowing users to see are all essential to the use and  
9 purpose of the article because they keep the user's face warm while allowing the user to see  
10 and breathe. Further, functional features of a product are features which constitute the actual  
11 benefit that the consumer wants to purchase, as distinguished from an assurance that a  
12 particular entity made, sponsored, or endorsed a product. Rachel, 831 F.2d at 1506. The Court  
13 concludes that the design of Seirus' products yields a utilitarian advantage.

14 Moreover, Seirus touts the utilitarian advantage and functionality in Seirus' advertising  
15 materials. "If a seller advertises the utilitarian advantages of a particular feature, this  
16 constitutes strong evidence of functionality." McCarthy, § 7:74 at 7-152. For example, Seirus  
17 promotes the NEOFLEECE COMBO SCARF as "[o]ffering the ultimate protection from cold"  
18 and having a "[v]ent at nose and vent holes at mouth [to] allow for free breathing." (Doc. No.  
19 75-1 at 10-11 citing (No. 09-CV-102-H (WMC), Murray Decl. ¶ 13).) The Court concludes  
20 that Seirus' advertisements tout the utilitarian benefit of the products' design by promising to  
21 protect a user from the cold while venting at the nose and mouth.

22 Despite Seirus' attempt to point to alternative designs, Seirus has failed to produce  
23 evidence to support the non-functionality of the products' design. Further, these particular  
24 designs result from a comparatively simple method of manufacture because the features are  
25 based on a desire to protect the contours of a person's face from the elements while permitting  
26 the user to see and breathe.

27 Additionally, the Court concludes that Seirus' utility patents are strong evidence that  
28 the features of these products are functional. "A utility patent is strong evidence that the



1 features therein claimed are functional.” TraFFix, 532 U.S. at 29-30. Seirus has an expired  
2 utility patent, U.S. Patent No. 4,300,240, claiming a cold weather mask sized and shaped to  
3 fit about the face, an angled nose, and an arcuate chin. (Doc. No. 75-1 at 10.) Further, Seirus  
4 has an expired utility patent, U.S. Patent No. 4,825,474, claiming a cold weather mask with  
5 a curved upper edge contoured along the lower part of the eye socket areas. (Id.) Seirus’  
6 utility patents present strong evidence that the features of these products are functional.

7 Because Seirus’ alleged trade dress in its products is not registered, Seirus bears the  
8 burden of proving non-functionality. 15 U.S.C. § 1125(a)(3) (“In a civil action for trade dress  
9 infringement under this Act for trade dress not registered on the principal register, the person  
10 who asserts trade dress protection has the burden of providing that the matter sought to be  
11 protected is not functional.”). Based on the record before the Court, Seirus has failed to meet  
12 its burden of proof that its product design is not functional because Seirus’ design yields a  
13 utilitarian advantage, Seirus’ advertising touts this utilitarian advantage, and Seirus’ utility  
14 patents creates strong evidence that the features are functional. Accordingly, the Court  
15 concludes that Seirus’ products are functional.

#### 16 **b. Distinctiveness**

17 Defendants maintain that Seirus cannot meet its burden of establishing that the product  
18 features have acquired distinctiveness or secondary meaning. (Doc. No. 75-1 at 11-13.)  
19 Defendants rely on the Court’s record in Cabela’s, (No. 09-CV-102-H (WMC), Doc. No. 350),  
20 to demonstrate that Seirus has produced no evidence on secondary meaning and failed to  
21 conduct surveys or produce direct evidence from individual consumers. (Id.) Seirus contend  
22 that secondary meaning can be established through evidence that Defendants intentionally  
23 copied Seirus’ product. (Doc. No. 79 at 23.)

24 Distinctiveness may be established through either the inherent distinctiveness of a  
25 product or through evidence of acquired distinctiveness. A trade dress is inherently distinctive  
26 if its “intrinsic nature serves to identify a particular source of a product.” Two Pesos, Inc. v.  
27 Taco Cabana, Inc., 505 U.S. 763, 768 (1992). The Seabrook test is the predominant means for  
28 evaluating the inherent distinctiveness of a trade dress. Mattel, Inc. v. MGA Entm’t, Inc., 2011



1 WL 1114250, at \*63 (C.D. Cal. Jan 5, 2011). Under the Seabrook test, the court must  
2 determine whether (1) the design or shape is a common, basic shape or design; (2) it is unique  
3 or unusual in a particular field; and (3) it is a mere refinement of a commonly adopted and well  
4 known form of ornamentation for a particular class of goods which consumers view as mere  
5 ornamentation. Seabrook Foods, Inc. v. Bar-Well Foods Ltd., 568 F.2d 1342 (C.C.P.A. 1977).  
6 In other words, courts look at whether the alleged trade dress is so uniquely designed that a  
7 buyer will rely on it to differentiate the source of the product.

8 Trade dress in product configurations such as those at issue in this case, can never be  
9 inherently distinctive. Wal-Mart, 529 U.S. at 213 (product design almost always serves a  
10 purpose other than source identification thus a consumer's disposition to equate the feature  
11 with the source does not exist). Instead, the proponent of the trade dress must show that the  
12 product configuration has acquired distinctiveness – or secondary meaning. Id. at 216 (holding  
13 that “a product's design is distinctive, and therefore protectable, only upon a showing of  
14 secondary meaning”). Secondary meaning, or acquired distinctiveness, is the “mental  
15 association by a substantial segment of consumers and potential customers between the alleged  
16 trade dress and a single source of the product.” Levi Strauss & Co. v. Blue Bell, Inc., 778 F.2d  
17 1352, 1354 (9th Cir. 1985) (en banc) (internal quotation marks omitted).

18 Secondary meaning may be established either through direct or circumstantial evidence.  
19 See, e.g., Cont'l Lab., 114 F. Supp. 2d at 999; Express, LLC v. Forever 21, Inc., 2010 WL  
20 3489308 (C.D. Cal. Sept. 2, 2010). Direct evidence includes results of an expert survey or  
21 direct consumer testimony. Yankee Candle Co. v. Bridgewater Candle Co., 259 F.3d 25, 43  
22 (1st Cir. 2001); Walker & Zanger, Inc. v. Paragon Indus., Inc., 549 F. Supp. 2d 1168 (N.D.  
23 Cal. 2007) (“An expert survey of purchasers typically provides the most persuasive evidence  
24 of secondary meaning.”). Alternatively, a plaintiff “may also establish secondary meaning  
25 through circumstantial evidence, such as: exclusivity, manner, and length of use, amount and  
26 manner of advertising, amount of sales and the number of customers, and plaintiff's established  
27 place in the market.” Clamp Mfg. Co. v. Enco Mfg. Co., 870 F.2d 512, 517 (9th Cir. 1989);  
28

1 Cont'l Lab, 114 F. Supp. 2d 992, 1000 (S.D. Cal. 2000) (citing Filipino Yellow Pages v. Asian  
2 Journal Publ'ns, 198 F.3d 1143, 1151 (9th Cir. 1999)).

3 Evidence of deliberate copying may, in appropriate cases, support an inference of  
4 secondary meaning. Fuddruckers, Inc. v. Doc's B.R. Others, Inc., 826 F.2d 837, 844-45 (9th  
5 Cir. 1987). Evidence of deliberate copying does not always support an inference of secondary  
6 meaning because "[c]ompetitors may intentionally copy product features for a variety of  
7 reasons. Competitors may, for example, choose to copy wholly functional features that they  
8 perceive as lacking any secondary meaning because of those features' intrinsic economic  
9 benefits." Id.

10 Seirus offers an exhibit that displays images of Seirus' products and Defendants'  
11 products, side-by-side, as evidence of intentional copying. (See Doc. No. 79, Ex. 9 to Edwards  
12 Decl.) The exhibit does not raise a triable issue of fact of secondary meaning. Competitors  
13 may copy features that are wholly functional that they perceive lack secondary meaning. The  
14 Court concludes that Seirus has not met its burden of proof that its products are nonfunctional.

15 Following the Court's ruling in Cabela's, (No. 09-CV-102-H (WMC), Doc. No. 350),  
16 the Court has permitted Seirus an opportunity to show secondary meaning in this case.  
17 Significantly lacking from Seirus' record is any evidence of consumer surveys or proof of  
18 secondary meaning. Seirus' marketing and media evidence does not prove that Seirus'  
19 products acquired secondary meaning. See Levi Strauss & Co., 778 F.2d at 1354 (noting that  
20 secondary meaning, or acquired distinctiveness, is the "mental association by a substantial  
21 segment of consumers and potential customers between the alleged trade dress and a single  
22 source of the product"). Seirus' evidence does not suggest that a substantial segment of  
23 consumers and potential consumers have a mental association between the alleged trade dress,  
24 a beak shaped nose, a triangular opening below the nose and above the mouth, a diamond  
25 shaped set of holes in the mouth area, or logo placed proximate the cheek bone with the Seirus  
26 brand. In fact, Seirus does not cite any evidence from consumer surveys or consumer  
27 testimony. Instead, Seirus cites testimony from a Seirus representative who states that Seirus'  
28 evidence of secondary meaning comes from the representative's "general communication with

1 consumers I see, people I see, buyers I see, reps I see and talk to.” (Doc. No. 79, Ex. 10 at 51  
2 to Murphey Decl.)

3 The nonmoving party cannot oppose a properly supported summary judgment motion  
4 by “rest[ing] on mere allegations or denials of his pleadings.” Anderson, 477 U.S. at 256.  
5 “The ‘opponent must do more than simply show that there is some metaphysical doubt as to  
6 the material fact.’” Kennedy, 952 F.2d at 265-66 (citing Matsushita Elec., 475 U.S. at 586).  
7 Once Defendants filed a summary judgment motion, Seirus had to come forward with evidence  
8 and cannot merely oppose Defendants’ motion. Seirus cannot wait until designation of experts  
9 to demonstrate secondary meaning. Because Seirus must come forward with evidence and  
10 failed to do so, the Court concludes that Seirus has failed to demonstrate secondary meaning.

11 “Consumers should not be deprived of the benefits of competition with regard to the  
12 utilitarian and esthetic purposes that product design ordinarily serves by a rule of law that  
13 facilitates plausible threats of suit against new entrants based upon alleged inherent  
14 distinctiveness.” Wal-Mart, 529 U.S. at 213. The Supreme Court further stated, “[i]n the case  
15 of product design, as in the case of color, we think consumer predisposition to equate the  
16 feature with the source does not exist.” Id. Therefore, proof of secondary meaning requires  
17 Seirus to provide evidence that a substantial segment of consumers have a mental association  
18 between Seirus’ alleged trade dress and Seirus as the source of the product. Levi Strauss &  
19 Co., 778 F.2d at 1354. Seirus has not met its burden. Accordingly, the Court concludes that  
20 Seirus’ alleged trade dress claims in its products fails for distinctiveness.

### 21 **c. Likelihood of Confusion**

22 The Ninth Circuit’s test for a likelihood of confusion in a trademark infringement case  
23 is set forth in AMF, Inc. v. Sleekcraft Boats, 599 F.2d 341 (9th Cir. 1979). The Ninth Circuit  
24 considers eight factors: (1) strength of the plaintiff’s mark; (2) relatedness or proximity of the  
25 goods or services; (3) similarity of the marks; (4) evidence of actual confusion; (5) marketing  
26 channels used; (6) likely degree of purchaser care; (7) defendant’s intent in selecting the mark;  
27 and (8) likelihood of expansion of the product lines. These factors are equally applicable to  
28

1 a trade dress infringement case. Mattel, 2011WL 1114250, at \*67 (applying Sleekcraft factors  
2 in trade dress infringement analysis).

3 Because Seirus' products are functional and lack distinctiveness, Seirus' products are  
4 not protectable as trade dress. Accordingly, the Court need not address the parties' remaining  
5 arguments pertaining to likelihood of confusion. Rachel, 831 F.2d at 1507 n.2 ("Because we  
6 find that the district court directed a verdict on functionality, we need not decide whether  
7 Rachel submitted sufficient evidence on the issues of secondary meaning and consumer  
8 confusion."); Walker & Zanger, 549 F. Supp. 2d at 1181 (granting summary judgment after  
9 finding trade dress was not protectable); Cont'l Lab., 114 F. Supp. 2d at 1016 n.22 ("Having  
10 found that Continental cannot show two essential elements of trade dress infringement  
11 (distinctiveness or nonfunctionality), the Court need not reach the parties remaining arguments  
12 pertaining to likelihood of confusion."); Autodesk, Inc. v. Dassault Sys. Solidworks Corp., 685  
13 F. Supp. 2d 1001, 1016 n.3 (N.D. Cal. 2009) ("Since defendant has shown that plaintiff cannot  
14 meet its burden concerning distinctiveness, arguments concerning functionality and likelihood  
15 of confusion need not be addressed."). The Court need not reach the parties' remaining  
16 arguments pertaining to likelihood of confusion because the Court concludes that Seirus' trade  
17 dress claim fails because Seirus' products are functional and lack distinctiveness. Accordingly,  
18 the Court grants Defendants' motion for summary adjudication of Seirus' trade dress claims  
19 in its products.

## 20 **2. Seirus' Alleged Trade Dress in its Packaging**

21 Seirus claims trade dress in its packaging. (Doc. No. 9 at ¶¶ 13-14.) Seirus identifies  
22 the packaging trade dress as the alleged product trade dress, that "when mounted, the Seirus  
23 Product Design Trade Dress appears in profile." (Doc. No. 79, Ex. 5 to Murphey Decl. at 7.)  
24 This alleged trade dress is identical to the one Seirus alleged in Cabela's. (No. 09-CV-102-H  
25 (WMC), Doc. No. 229, Murray Decl. ¶ 2, Ex. A at 4.) Seirus did not supplement the record to  
26 oppose Defendants' motion regarding Seirus' alleged packaging trade dress.

27 Similar to Seirus' alleged product trade dress, Seirus' alleged packaging trade dress is  
28 also not registered with the United States Patent and Trademark Office. Therefore, in order

1 to prevail on a claim for infringement of an unregistered trade dress, Seirus bears the burden  
2 to prove each of the following elements: (1) that the trade dress is nonfunctional; (2) that the  
3 plaintiff owns a protectable trade dress in a clearly articulated design or combination of  
4 elements that is either inherently distinctive or has acquired distinctiveness through secondary  
5 meaning; and (3) the accused mark or trade dress creates a likelihood of confusion as to source,  
6 or as to sponsorship, affiliation or connection. 15 U.S.C. § 1125(a)(3); Art Attacks Ink, 581  
7 F.3d at 1145. Accordingly, in order for Seirus to succeed on its trade dress claims, Seirus must  
8 first establish that it has protectable trade dress rights in its packaging.

9 **a. Nonfunctional**

10 The Ninth Circuit weighs four factors in determining whether a product feature is  
11 functional: (1) whether the design yields a utilitarian advantage; (2) whether alternative designs  
12 are available; (3) whether advertising touts the utilitarian advantages of the design; and (4)  
13 whether the particular design results from a comparatively simple or inexpensive method of  
14 manufacture. Disc Golf, 158 F.3d at 1006. Importantly, the plaintiff bears the burden of  
15 proving non-functionality – the accused need not prove that the trade dress at issue is  
16 functional. Rachel, 831 F.2d at 1506.

17 Defendants rely on the evidence from Cabela's, (No. 09-CV-102-H (WMC), Doc. No.  
18 350), to demonstrate that Seirus' packaging is functional. (Doc. No. 75-1 at 14-15.)  
19 Specifically, Defendants argues that Seirus' Co-President, Carey, testified that the profile  
20 display of its packaging aids consumers in viewing the product. (Doc. No. 75-1 at 13 (citing  
21 Cabela's, No. 09-CV-102-H (WMC), Doc. No. 229, Murray Decl. ¶ 5, Ex. D (Carey Dep. Tr.  
22 at 102:3-8)).) Further, Defendants cites evidence that when Carey was asked whether there  
23 were alternative methods of packaging the Seirus products which would not infringe the  
24 alleged trade dress, Carey stated that the product could be placed in a box. (Id.) However,  
25 Carey then acknowledged that the consumer would be unable to view the product without  
26 taking it out of the box. (Id.) Based on the record, the Court concludes that Seirus' packaging  
27 serves a utilitarian advantage because it permits the purchaser to view the product. Disc Golf,  
28 158 F.3d at 1006. Seirus bears the burden of proving non-functionality – the accused need not

1 prove that the trade dress at issue is functional, and Seirus has failed to meet that burden.  
2 Rachel, 831 F.2d at 1506. The Court concludes that Seirus has not met its burden of proving  
3 non-functionality of its packaging.

4 **b. Distinctiveness**

5 Defendants maintain that Seirus' packaging has not acquired distinctiveness or  
6 secondary meaning. (Doc. No. 75-1 at 15-16.) Specifically, Defendants contend that Seirus  
7 has produced no evidence to support a finding of inherent distinctiveness. (Id.) The Court  
8 agrees.

9 Distinctiveness may be established through either the inherent distinctiveness of a  
10 product or through evidence of acquired distinctiveness. A trade dress is inherently distinctive  
11 if its "intrinsic nature serves to identify a particular source of a product." Two Pesos, Inc., 505  
12 U.S. at 768. The Seabrook test is the predominant means for evaluating the inherent  
13 distinctiveness of a trade dress. Mattel, 2011 WL 1114250, at \*63. Under the Seabrook test,  
14 the court must determine whether (1) the design or shape is a common, basic shape or design;  
15 (2) it is unique or unusual in a particular field; and (3) it is a mere refinement of a commonly  
16 adopted and well known form of ornamentation for a particular class of goods which  
17 consumers view as mere ornamentation. Seabrook, 568 F.2d 1342. In other words, courts look  
18 at whether the alleged trade dress is so uniquely designed that a buyer will rely on it to  
19 differentiate the source of the product.

20 Defendants cite evidence from Cabela's that Seirus' packaging is a reproduction of  
21 packaging commonly used in the clothing industry. (Doc. No. 75-1 at 16 (citing Cabela's, No.  
22 09-CV-102-H (WMC), Doc. No. 229, Murray Decl. ¶ 6, Ex. E (Marcovitch Dep. Tr. at 90:14-  
23 91:5)) ("There were quite a number of people that were using side profile packaging. I  
24 remember people like Turtle Fur were using it quite extensively. There were just a number of  
25 companies selling all sorts of accessories, you know, within our marketplace, mostly  
26 Balaclavas. If you went outside of our market, there were people selling scarves in the fashion  
27 market. It wasn't necessarily something that unique to put a face cardboard, you know,  
28 attached to a product. People in the Halloween mask business have been doing it for quite a

1 while.”). Seirus fails to cite evidence that its packaging is so uniquely designed that a buyer  
2 would rely on it to differentiate the source of the product. In fact, Seirus does not cite any  
3 evidence to support distinctiveness in its packaging. See Mattel, 2011 WL 1114250, at \*64  
4 (finding no inherent distinctiveness at summary judgment phase for trapezoidal packaging that  
5 is commonly used in the toy industry).

6 Additionally, the nonmoving party cannot oppose a properly supported summary  
7 judgment motion by “rest[ing] on mere allegations or denials of his pleadings.” Anderson, 477  
8 U.S. at 256. “The ‘opponent must do more than simply show that there is some metaphysical  
9 doubt as to the material fact.’” Kennedy, 952 F.2d at 265-66 (citing Matsushita Elec., 475 U.S.  
10 at 586). Once Defendants filed a summary judgment motion, Seirus had to come forward with  
11 evidence and cannot merely oppose Defendants’ motion. Seirus cannot wait until designation  
12 of experts to demonstrate secondary meaning. Because Seirus must come forward with  
13 evidence and did not do so, the Court concludes that Seirus has failed to demonstrate  
14 secondary meaning. Accordingly, the Court concludes that Seirus’ packaging trade dress  
15 claims fail for lack of distinctiveness.

### 16 **c. Likelihood of Confusion**

17 Because Seirus’ packaging is functional and lacks distinctiveness, Seirus’ packaging  
18 is not protectable as trade dress. Accordingly, the Court need not address the parties’  
19 remaining arguments pertaining to likelihood of confusion. Rachel, 831 F.2d at 1507 n.2  
20 (“Because we find that the district court directed a verdict on functionality, we need not decide  
21 whether Rachel submitted sufficient evidence on the issues of secondary meaning and  
22 consumer confusion.”); Autodesk, 685 F. Supp. 2d at 1016 n.3 (“Since defendant has shown  
23 that plaintiff cannot meet its burden concerning distinctiveness, arguments concerning  
24 functionality and likelihood of confusion need not be addressed.”); Walker & Zanger, 549 F.  
25 Supp. 2d at 1181 (granting summary judgment after finding trade dress was not protectable);  
26 Cont’l Lab., 114 F. Supp. 2d at 1016 n.22 (“Having found that Continental cannot show two  
27 essential elements of trade dress infringement (distinctiveness or nonfunctionality), the Court  
28 need not reach the parties remaining arguments pertaining to likelihood of confusion.”). The



1 Court need not reach the parties' remaining arguments pertaining to likelihood of confusion  
2 because the Court concludes that Seirus' packaging trade dress claim fails because Seirus'  
3 packaging is functional and lacks distinctiveness. Therefore, the Court grants Defendants'  
4 motion for summary adjudication of Seirus' trade dress claims pertaining to Seirus' products  
5 and packaging.

6 **C. Seirus' False Designation of Origin and Unfair Competition Causes of Action**

7 Defendants move for summary adjudication on Seirus' causes of action for false  
8 designation of origin and unfair competition under the Lanham Act and California law. (Doc.  
9 No. 75-1 at 17.) These causes of action are based on Seirus' alleged product and packaging  
10 trade dress. Because Seirus has no protectable product or packaging trade dress, these causes  
11 of action also fail. (*Id.*)

12 Seirus' false designation of origin and unfair competition causes of action under the  
13 Lanham Act, 15 U.S.C. § 1125(a), both require that Seirus have an underlying trade dress  
14 protection. The only way a copied product design – or configuration – can confuse as to its  
15 source is if the product design that was copied is by itself, without any other source indicators  
16 such as trademarks, packaging or symbols, an indicator of a single source or origin; meaning  
17 it has become protectable configuration trade dress. *See, e.g., Wal-Mart*, 529 U.S. at 210  
18 (“[W]ithout distinctiveness the trade dress would not cause confusion . . . as to the origin,  
19 sponsorship, or approval of [the] goods as section [43a] requires.”); *Yankee Candle*, 259 F.3d  
20 at 41-42 (affirming summary judgment of no unfair competition under Lanham Act and stating  
21 “the relevant intent is not just intent to copy, but to ‘pass off one’s goods as those of another”).  
22 Based on the foregoing, the Court concludes that Seirus' products and packaging do not “cause  
23 confusion . . . as to the origin, sponsorship, or approval of [the] goods as section [43a]  
24 requires.” *Wal-Mart*, 529 U.S. at 210. Therefore, the Court concludes that Seirus' false  
25 designation of origin and unfair competition causes of action under the Lanham Act fail  
26 because Seirus does not have the requisite trade dress protection. Accordingly, the Court  
27 grants Defendants' motion for summary adjudication of Seirus' false designation of origin and  
28 unfair competition causes of action under the Lanham Act.



Finally, Seirus' California unfair competition cause of action alleges that Defendants' acts of intentional and willful trade dress infringement constitute unfair competition actionable under the laws of the State of California. (Doc. No. 1, Complaint, at ¶ 49.) Because the Court concluded that Seirus does not have protectable trade dress in its products and packaging, Seirus' claim for unfair competition based on trade dress infringement fails. Based on the foregoing, the Court grants Defendants' motion for summary adjudication of Seirus' false designation of origin and unfair competition causes of action under the Lanham Act and California law.

#### **D. Seirus' Unjust Enrichment Cause of Action**

Defendants argue that because Seirus' alleged product and packaging trade dress fail, because Seirus' '804 patent is invalid, and because Defendant Balboa's accused products do not infringe the '690 patent, Balboa cannot be unjustly enriched by use, if any, of Seirus' alleged trade dress or patented inventions. (Doc. No. 75-1 at 18.) The Court agrees. Accordingly, the Court grants Defendants' motion for summary adjudication of Seirus' unjust enrichment cause of action.

#### **II. Request for Judicial Notice**

Pursuant to Fed. R. Evid., Rule 201 and Cal. Evid. C., § 452(d)(1), Defendants requests that this Court take judicial notice of the Court's own files, records, and orders from the case Cabela's, No. 09-CV-102-H (WMC) (Doc. Nos. 75-2; 76-2.) After reviewing Defendants' request, the Court takes judicial notice that Seirus already litigated these identical products and the Court determined that Seirus' products are functional and lack distinctiveness, meaning Seirus' claims based on alleged trade dress protection fail. (No. 09-CV-102-H (WMC), Doc. No. 350.) Additionally, the Court already granted summary judgment in favor of a Defendant in Cabela's, 2011 U.S. Dist. LEXIS 123697, at \*1, on the issue of the noninfringement of Seirus' '690 patent and invalidity of claims 1-5, 8-12, and 13-15 of Seirus' '804 patent.

Federal Rule of Evidence 201 permits judicial notice of adjudicative facts, which are defined as facts "not subject to reasonable dispute." Fed. R. Evid. 201(b). A judicially noticed fact must be one that is not subject to reasonable dispute in that it is either: (1) generally known

1 within the territorial jurisdiction of the trial court or (2) capable of accurate and ready  
2 determination by resort to sources whose accuracy cannot reasonably be questioned. Fed. R.  
3 Evid. 201(b). As to matters for which collateral estoppel applies, the court takes judicial notice  
4 of the filings, records, and orders from Cabela's and recognizes that it has previously construed  
5 these patents and issues. As to matters for which collateral estoppel does not apply, the Court  
6 recognizes that these records, filings, and orders are not binding in the present case.

7 **Conclusion**

8 Based on the foregoing, the Court:

9 (1) GRANTS Defendants' motion for summary adjudication as to the invalidity of  
10 claims 1-18 of the '804 patent for obviousness;

11 (2) GRANTS Defendants' motion for summary adjudication as to noninfringement of  
12 claim 1 of the '690 patent;

13 (3) GRANTS Defendants' motion for summary adjudication of Seirus' trade dress  
14 claims pertaining to Seirus' products and packaging;

15 (4) GRANTS Defendants' motion for summary adjudication of Seirus' false designation  
16 of origin and unfair competition causes of action under the Lanham Act and California law;

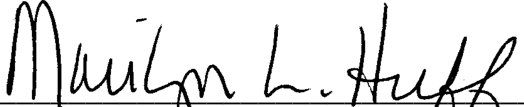
17 (5) GRANTS Defendants' motion for summary adjudication of Seirus' unjust  
18 enrichment cause of action;

19 (6) DENIES Seirus' motion for relief pursuant to Rule 56(d); and

20 (7) GRANTS Defendants' request for judicial notice.

21 **IT IS SO ORDERED.**

22 DATED: February 3, 2012

23   
24 MARILYN L. HUFF, District Judge  
25 UNITED STATES DISTRICT COURT  
26  
27  
28